

REMARKS

Claims 1-24 are pending in the above-referenced application. After an earlier restriction requirement wherein Group II method claims were elected, The Examiner has now required Applicant to elect a single species. Accordingly, Applicant hereby provisionally elects, with traverse, the following species, identified in the terminology and manner suggested by the Examiner, the basis of which the Applicant traverses for reasons set forth after the election:

Species Element A- Method of making: Election is A4- filling between substrates, shown but not limited to that shown in FIGS 22-27.

Species Element B-Method of Polymerizing and (possibly) aligning: Election is as shown and described in conjunction with FIG. 26 and 27.

Species Element C-Device Configurations: Election is made for FIG. 27 for search purposes. It is noted that in a Method invention the article being made is not limitative nor particularly relevant to search and examination of method claims.

Species Element D-Particles: Election is to the simplest form of OLED shown in FIG. 2.

Species Element E- Final Use: Election is to FIG. 1 and FIGS. 66A-C. Again it is noted that final utility for the article made in the method of manufacture is not restrictive and not relevant to search and examination of method claims.

Claims readable thereon are believed to be Claims 1-24.

I. Traversal

Applicants initially point out that Examiner's requirement for species restriction creates dozens of potentially separate species invention possibilities out of only 24 pending claims. While the election may be requested in order to simplify the search that must be balanced against the potential burden on both the Office and Applicant in the long run.

In this regard, Applicant respectfully submits that examination of all pending claims 1-24 of the present application is far less burdensome for both Applicant and Examiner than

would be prosecution of potentially dozens of separately filed applications as a result of Examiner's species restriction, should the generic claims not be found to be patentable.

At a minimum, Applicant respectfully requests that Examiner identify the classification for the many alleged species characteristics, A, B C D and E. Many may share common class and subclass classifications. Applicant respectfully submits that such consolidation will impose no serious burden on examination, nor has Examiner alleged that such a burden exists as required under the rules.

A. Groupings.

Examiner has not identified any class or subclass designations for any of the proposed species and subspecies groupings and that is a minimum requirement of a proper restriction requirement.

**B. Groupings Sharing The Same Classification
May Be Consolidated In Accordance With the Rules**

The criteria for restriction is set forth in section 803 of the MPEP as follows:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct; and*
- (B) There must be a serious burden on the examiner if restriction is required. (emphasis added) (internal citations omitted).*

Concerning the second prong, § 803 instructs that examiners establish a "serious burden" by demonstrating one of three *prima facie* elements:

- (A) the inventions have a separate classification;
- (B) the inventions have a separate status in the art; or,
- (C) the inventions have a different field of search, as defined in MPEP § 808.02.

C. Examiner Does Not Allege That Examination Of Claims Sharing The Same Classification Would Impose A Serious Burden.

(i) Most claims share a common classification

Though Examiner might satisfy the *prima facie* case with respect to inventions which are ultimately identified as having separate classifications, Examiner should properly at least assert that examination of inventions sharing the same classification imposes a similar serious burden. Applicant respectfully submits there is no such justification in this instance.

Rather, Examiner has not properly even alleged that the variously defined inventions are “independent” or “distinct” which does not even satisfy the first prong of this two prong test. As § 803 makes clear, independent or distinct inventions must still be examined collectively, i.e., not restricted, unless such examination would impose a serious burden on the examiner.

(ii) A separate status in the art is not alleged for the alleged many species or subspecies groups

Section 803 makes clear that an Examiner may also demonstrate a serious burden where the inventions have acquired a separate status in the art. This requirement is satisfied only with respect to inventions of different classifications.

Accordingly, Examiner’s restriction also fails to satisfy the second *prima facie* element under § 803.

(iii) Different Field of Search

The third *prima facie* element specifies that Examiner may demonstrate that the inventions require a “different field of search.” A different field of search is found where it is “necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists” (MPEP § 808.02). However, Examiner makes no allegation that a distinct field of search is required.

Accordingly, Examiner's rejection also fails to satisfy the third and final *prima facie* element under § 803. Certainly, none of the three factors of the *prima facie* case would be satisfied with respect to inventions sharing the same classification. It cannot be maintained, therefore, that these inventions impose a serious burden.

**D. Where There Is No Serious Burden
Examination Of The Entire Case "Must" Occur**

Here the MPEP is clear:

If the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (MPEP § 803) (emphasis added).


CONCLUSION

Accordingly, Applicant respectfully requests that Examiner reconsider and withdraw the present restriction requirement, and revise the restriction requirement to remove the species requirements set forth.

If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is invited to telephone the undersigned.

A check in the amount of \$225.00 is enclosed to cover the fee for a two (2) month extension of time. If it is determined that additional fees are due, they may be charged to Deposit Account No. 503342, maintained by the attorneys.

Respectfully submitted,

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